

REMARKS

I. Introduction

Claims 17, 19-22, 24-28 and 30-33 are currently pending in the present application. Claims 17, 27 and 32 have been amended. For at least the reasons set forth below, Applicants submit that the pending claims are in condition for allowance.

II. Rejection of Claims 17, 20, 21 and 27, 28 and 30-33 under 35 U.S.C. § 102

Claims 17, 20, 21 and 27, 28 and 30-33 were rejected under 35 U.S.C. § 102(b) as unpatentable over U.S. Patent No. 5,872,977 ("Thompson").

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Amended claim 17 recites, in relevant part, "**automatically generating at least one item of dependency information describing at least one of: whether a particular resource is reserved exclusively for use by the least one functional unit**, which comprises a software module in the computer program; **and a sequence in which additional computer scripts, which alter the configuration data stored in the configuration data container, must be executed.**" Claims 27 and 32 have been amended to recite limitations substantially similar to the above-recited limitations of claim 17.

Thompson fails to disclose or suggest any of the dependency information provided in claim 17, i.e., dependency information that describes whether a resource is reserved by a functional unit, and dependency information that describes a sequence in which additional computer scripts must be executed.

For at least the foregoing reasons, independent claims 17, 27 and 32, as well as their dependent claims 20, 21, 28, 30, 31 and 33, are allowable over Thompson.

Withdrawal of the anticipation rejection is respectfully requested.

III. Rejection of Claims 19, 22 and 24-26 under 35 U.S.C. § 103

Claims 19 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In addition, all the teachings of the prior art must be considered, including those which teach away from the claimed invention. (See M.P.E.P. 2143.01.II). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

As discussed above, Thompson fails to identically disclose or suggest all the features of claims 17. Accordingly, dependent claims 19 and 26 are allowable over Thompson for at least the same reasons as those present in connection with parent claim 17.

Claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson in view of U.S. Patent No. 7,234,135 ("Bollhoefer").

Bollhoefer fails to remedy the critical deficiencies of Thompson described above in connection with parent claim 17. Accordingly, dependent claim 22 is allowable over the combination of Thompson and Bollhoefer for at least the same reasons as those present in connection with parent claim 17.

Claims 24 and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson in view of U.S. Patent Pub. No. 2002/0040469 ("Pramberger").

Pramberger fails to remedy the critical deficiencies of Thompson described above as applied against parent claim 17. Accordingly, dependent claims 24 and 25 are allowable over the combination of Thompson and Pramberger for at least the same reasons as those present in connection with parent claim 17.

Withdrawal of the obviousness rejections is respectfully requested.

Conclusion

Applicants respectfully submit that all pending claims 17, 19-22, 24-28 and 30-33 of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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